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APR 23 2004

OFFICE OF PETITIONS

In re Application of	:	
Carrie Haskell-Luevano	:	
Application No. 10/602,394	:	DECISION ON PETITION
Filed: June 23, 2003	:	UNDER 37 C.F.R. §1.182
Attorney Docket No. UF-375	:	
Title: NOVEL MELANOCORTIN	:	
RECEPTOR TEMPLATES, PEPTIDES, AND	:	
USE THEREOF	:	

BACKGROUND

This is a decision on the petition under 37 C.F.R. §1.182, filed February 13, 2004, requesting that the executed declaration associated with the above-identified application be accepted as timely filed, and that the petition fee be waived.

The above-identified application was deposited on June 23, 2003, listing Carrie Haskell-Luevano as the sole inventor, with a declaration which was not executed. On September 8, 2003, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (notice), requiring an executed oath or declaration in compliance with §1.63 and a \$65 surcharge for its late filing. This Notice set a two-month period for reply.

With the instant petition, Petitioner has submitted a declaration which has been executed by the sole inventor along with the surcharge associated with the late submission of the same, a declaration of facts, an assertion that the notice was not received, and a request to have the petition fee waived and the declaration considered timely filed.

THE RELEVANT SECTION OF THE MPEP

MPEP 711.03(c) states, in part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

ANALYSIS

Regarding Petitioner's request that the declaration be considered to have been timely filed, this request cannot be granted, for the following reasons.

Petitioner has submitted a declaration of facts which asserts that a partner in the Petitioner's law firm has reviewed the docket report, and that the notice was not received. First, it is noted that the declarant states that he has reviewed the docket report, but he does not set forth that the notice does not appear on the docket report. Secondly, the statement does not make any reference to any search of the file jacket which corresponds to the instant application. Third, the declarant has not set forth that he has searched the place where this notice would normally be kept, had it been received. Fourth, a copy of the docket record where the non-received notice would have been entered had it been received and docketed has not been attached to the declarant's statement. Fifth, Petitioner has not included a copy of the file jacket associated with this application.

Even if Petitioner were to establish that the notice was not received, the executed declaration would not be considered timely filed, as the executed declaration was due on filing. The application was filed on June 23, 2003, and the executed declaration was not submitted until almost eight months later. A review of the electronic record shows that the declaration submitted on filing was not an executed declaration. As such, an acceptable declaration was not timely filed, and the Office will not determine that a declaration was properly submitted on filing when it is clear that such is not the case.

Regarding the waiver of the petition fee, the request cannot be granted, as petition fees are jurisdictional. Petitioner will note that the last sentence of 37 C.F.R. §1.182 specifically sets forth "Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h)." As such, the petition fee of \$130 has been charged to Petitioner's Deposit Account, as authorized in the petition, along with the surcharge associated with the late submission of an oath or declaration.

The declaration submitted with the instant petition will not be entered until either the petition under 37 C.F.R. §.182 is granted or the Petitioner corrects the deficiencies noted in the second paragraph of this section of the decision.

CONCLUSION

For these reasons, the petition under 37 CFR 1.182 is dismissed.

Petitioner is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the above-noted deficiencies. Any reply should be entitled "Renewed Petition Under 37 C.F.R. §1.182," and should only address the deficiencies noted above. **Failure to respond will result in abandonment of the application.**

Any extensions of time will be governed by 37 C.F.R. §1.136(a). Extensions of time under 37 CFR §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 CFR §1.182". This is not a final agency action within the meaning of 5 U.S.C 704.

Any renewed petition may be submitted by mail¹, hand-delivery², or facsimile³.

The reply should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. The Petitioner may wish to consider telephoning the undersigned at the number provided below to confirm that the documents were delivered to the undersigned. Please note that the delivery process within the PTO can take as much as three weeks.

The application file will be retained in the Office of Petitions for two (2) months.

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

2 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

3 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011.

A handwritten signature in black ink, appearing to read "Paul Shanoski". The signature is fluid and cursive, with the first name "Paul" and last name "Shanoski" clearly distinguishable.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office